generating an identification number associated with at least one paging service subscriber and storing the generated identification number in a central database;

programming a paging unit of the paging service subscriber with the identification number;

attaching an advertisement script to a page message for the paging service subscriber having the identification number programmed into the paging unit; and

transmitting the advertisement script and the message to the paging unit having the identification number,

wherein the step of generating the identification number associated with at least one paging service subscriber comprises generating a plurality of capcodes associated with at least one paging service subscriber.

REMARKS

By this amendment, claims 1-7, 14-17 and 19-22 are pending, in which claims 8-13, and 18 are cancelled, with claims 8-12 being withdrawn for consideration as directed to a non-elected invention. Thus, 15 claims are pending, of which 6 claims are independent.

In the present Office Action, claims 1, 2, 4, 5, 7 and 13-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Taubenheim et al.* (US 6,060,997); claims 3 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taubenheim et al.* in view of *DeLuca et al.* (US 5,870,030); and claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taubenheim et al.* in view of *Yeh et al.* (US 6,208,717)

The present amendment rewrites dependent claims 13 (claim 1 as amended), 14, 16, 18 (claim 5 as amended), 19 and 21 in independent form. Thus, the present amendment does not

raise new issues requiring the Examiner's further search and/or consideration. Accordingly, entry of the present amendment is in order.

Independent claims 1 and 5, as amended, and claims dependent therefrom, are patentably distinguishable over *Taubenheim et al.*, taken alone or in combination with *DeLuca et al.* or *Yeh et al.* For example, independent claim 1, as amended, recites:

> **generating an identification number associated with at least one paging service subscriber;** and
> attaching an advertisement script to a page message for the paging service subscriber having the identification number,
> **wherein the step of generating the identification number comprises generating a capcode;** and

independent claim 5, as amended, recites:

> **generating an identification number associated with at least one paging service subscriber and storing the generated identification number in a central database;**
> programming a paging unit of the paging service subscriber with the identification number;
> attaching an advertisement script to a page message for the paging service subscriber having the identification number programmed into the paging unit; and
> transmitting the advertisement script and the message to the paging unit having the identification number,
> **wherein the step of generating the identification number comprises generating a capcode.**

By contrast, *Taubenheim et al.* discloses utilizing a paging unit's existing physical address for effectuating advertisement delivery (col. 2:34-41). However, this use of a physical address for effectuating advertisement delivery is not disclosed to involve use of a capcode, as recited independent claims 1 and 5. Furthermore, the only disclosure of capcodes in *Taubenheim et al.* is with respect to determining intervals for receiving segments of frames of information and not for "attaching an advertisement script," as recited in independent claims 1 and 5. Specifically, *Taubenheim et al.* discloses, at col. 9:4-12 (emphasis added), that:

The processor determines and generates the control data to be included in the frames to inform the selective call device the rate and the frames in which the information will be broadcast, step 910. The information and the control data are generated indicative of the number of frames and the transmission rate, step 912. **If the frame is capcode assigned, the address is encoded in the frame so that the selective call device expects to receive each segment at regular intervals.**

Taubenheim et al. is further deficient with respect to claims 14-17 and 19-22. For example, independent claims 14 and 19 recite "generating an identification number associated with at least one paging service subscriber, including generating a plurality of capcodes corresponding to a plurality of paging service subscriber types," and claims 15 and 20 recite "generating the plurality of capcodes corresponding to a plurality of paging service subscriber types including at least one of residential paging service subscribers, business paging service subscribers, small business paging service subscribers, and large business paging service subscribers," which also is not disclosed by *Taubenheim et al.*

In rejecting claims 14, 15, 19 and 20, the present Office Action merely lumps the rejection of these claims together and makes a conclusory assertion that "since each subscriber has a unique identifier, each capcode would correspond to the individual service" (Office Action, p. 2). However, such a conclusory assertion is unsupported by *Taubenheim et al.*, which as explained above merely discloses using capcodes to determine intervals for receiving segments of frames of information. Thus, *Taubenheim et al.* does not support a rejection of claims 14, 15, 19 and 20 under § 102. In addition, the rejection of claims 16, 17, 21 and 22 would be similarly unsupported.

With respect to claim 15, the present Office Action later admits that *Taubenheim et al.* fails to disclose "capcodes corresponding to residential, small or large business service types"

(Office Action, p. 3), which is consistent with above arguments patentably distinguishing *Taubenheim et al.* The present Office Action then attempts to cure such admitted deficiency in *Taubenheim et al.* by asserting that "Yeh et al teaches differentiating a messaging service on the basis of residential, small and large business types" citing col. 10:6-14 of *Yeh et al.* However, the present Office Action fails to provide **any** motivation for modifying *Taubenheim et al.* in view of *Yeh et al.* Thus, no *prima facie* case for obviousness has been made.

Nonetheless, *Yeh et al.*, col. 10:6-14, merely discloses a pre-migration procedure for a messaging system that "Reassign COS Id to the source application mailboxes if the COS is shared by different type (residential, small business, and large business) of mailboxes." However, such a general disclosure of reassigning an ID to source application mailboxes if shared by different types (residential, small business, and large business) of mailboxes fails to teach or suggest "generating the plurality of capcodes corresponding to a plurality of paging service subscriber types including at least one of residential paging service subscribers, business paging service subscribers, small business paging service subscribers, and large business paging service subscribers," as required by claims 15 and 20.

Similarly, dependent claim 2 recites "storing the generated identification number in a central database," which is not disclosed by *Taubenheim et al.* The present Office Action attempts to cure such deficiency in *Taubenheim et al.* by asserting that such feature is inherent in a paging system and citing col. 5:25-48 of *Taubenheim et al.*

However, to establish inherency, it must be clear that the missing descriptive matter is necessarily present in the reference. *In re Roberston*, 49 USPQ2d at 1951. Under the principles of inherency, the prior art must necessarily function in accordance with, or include, the claim limitations. *MEHL/Biophile Int'l.*, No. 99-1038 at § II, 4. Since *Taubenheim et al.* discloses

using an existing address of paging unit, generating an identification number is not necessary and therefore "storing the [generated] identification number in a central database" cannot be inherent. With respect to col. 5:25-48 of *Taubenheim et al.*, this disclosure is directed to the paging unit 130 and is not directed to "storing the generated identification number in a central database."

With respect to the remaining applied references, *DeLuca et al.* is directed to a system 20 for permitting a user of a selective call receiver 31 to receive a certain number of personal messages and information service updates without paying a fee for such services in return for reading advertisements wirelessly transmitted to the selective call receiver (Abstract and FIG. 5). As noted above, *Yeh et al.* is directed to a method for migrating or altering a messaging system (Abstract and FIG. 1). However, *DeLuca et al.* and *Yeh et al.* fail to cure the noted deficiencies in *Taubenheim et al.*

The remaining dependent claims are patentably distinguishable over *Taubenheim et al.*, taken alone or in combination with *DeLuca et al.* and *Yeh et al.*, own their own merits and for substantially the same reasons as discussed with respect to independent claims 1, 5, 14, 16, 19 and 21.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. §§ 102 and 103 by amending dependent claims 13, 14, 16, 18, 19 and 21 in independent form, the present amendment raises no new issues requiring the Examiner's further search and/or consideration and places the application in better form for
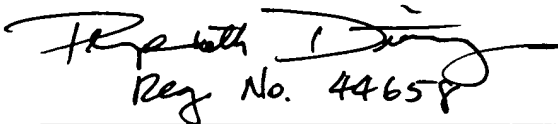
consideration on appeal. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally

construed, and that the present amendment be entered.

Therefore, the present response overcomes the rejections of record, placing the present

application in condition for allowance. Favorable consideration is respectfully requested. If any

unresolved issues remain, it is respectfully requested that the Examiner telephone the

undersigned attorney at 703-425-8501 so that such issues may be resolved as expeditiously as

possible.

Respectfully Submitted,

DITTHAVONG & CARLSON, P.C.

5/28/02

Date

Carlos R. Villamar
Attorney/Agent for Applicant(s)
Reg. No. 43,224

10507 Braddock Rd
Suite A
Fairfax, VA 22032
Tel. 703-425-8501
Fax. 703-425-8518

APPENDIX

Please cancel claims 8-13, and 18, without prejudice or disclaimer, and amend claims 1, 5, 14, 16, 19 and 21, as follows.

--1. (Twice Amended) A method for targeted marketing, comprising:

generating an identification number associated with at least one paging service subscriber; and

attaching an advertisement script to a page message for the paging service subscriber having the identification number,

wherein the step of generating the identification number comprises generating a capcode.

5. (Twice Amended) A method for attaching advertisements to messages received by paging units, comprising:

generating an identification number associated with at least one paging service subscriber and storing the generated identification number in a central database;

programming a paging unit of the paging service subscriber with the identification number;

attaching an advertisement script to a page message for the paging service subscriber having the identification number programmed into the paging unit; and

transmitting the advertisement script and the message to the paging unit having the identification number,

wherein the step of generating the identification number comprises generating a capcode.

8-13. (Cancelled).

14. (Amended) [The] A method [of Claim 1] for targeted marketing, comprising:

generating an identification number associated with at least one paging service

subscriber; and

attaching an advertisement script to a page message for the paging service subscriber

having the identification number,

wherein the step of generating the identification number associated with at least one

paging service subscriber comprises generating a plurality of capcodes corresponding to a

plurality of paging service subscriber types.

16. (Amended) [The] A method [of Claim 1] for targeted marketing, comprising:

generating an identification number associated with at least one paging service

subscriber; and

attaching an advertisement script to a page message for the paging service subscriber

having the identification number,

wherein the step of generating the identification number associated with at least one

paging service subscriber comprises generating a plurality of capcodes associated with at least

one paging service subscriber.

18. (Cancelled).

19. (Amended) [The] A method [of Claim 5] for attaching advertisements to messages

received by paging units, comprising:

generating an identification number associated with at least one paging service subscriber

and storing the generated identification number in a central database;

programming a paging unit of the paging service subscriber with the identification

number;

attaching an advertisement script to a page message for the paging service subscriber having the identification number programmed into the paging unit; and

transmitting the advertisement script and the message to the paging unit having the identification number,

wherein the step of generating the identification number associated with at least one paging service subscriber comprises generating a plurality of capcodes corresponding to a plurality of paging service subscriber types.

21. (Amended) [The] A method [of Claim 5] for attaching advertisements to messages received by paging units, comprising:

generating an identification number associated with at least one paging service subscriber and storing the generated identification number in a central database;

programming a paging unit of the paging service subscriber with the identification number;

attaching an advertisement script to a page message for the paging service subscriber having the identification number programmed into the paging unit; and

transmitting the advertisement script and the message to the paging unit having the identification number,

wherein the step of generating the identification number associated with at least one paging service subscriber comprises generating a plurality of capcodes associated with at least one paging service subscriber.--.